

REMARKS/ARGUMENTS

Status of the Claims

Claims 1-13, 19-21, and 23-24 are currently pending in the application. Claims 1-13 and 19 have been amended. No new matter has been added by the amendments. No claims have been added. No claims have been cancelled. Therefore, claims 1-13, 19-21, and 23-24 are present for examination. Claims 1 and 19 are independent claims. Applicants respectfully request reconsideration of this application as amended.

Claims 1-13, 19-21, and 23-24:

To establish a *prima facie* case of obviousness, all claim limitations must first be taught or suggested by the prior art. *See, e.g., DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006). "All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (*citing In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). The Examiner must then provide an explicit analysis supporting the rejection. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) ("a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art"). While the Examiner can choose one of several exemplary rationales from the MPEP to support an obviousness rejection under *KSR*, all the rationales still require the Examiner to demonstrate that all the claim elements are shown in the prior art. *See* MPEP § 2143, Original Eighth Edition, August 2001, Latest Revision July 2008.

The Office Action does not note the specific components of the payment enabler. For example, the Final Office Action fails to demonstrate which component in Levchin is the payment enabler and which parts of that component are the enabler interface, the payment controller, and the handler interface. Indeed, the particular teaching or associations between the cited art and the claim terms could not be found by the Applicants.

"In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command.

When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." 37 C.F.R. § 1.104(c)(2)

Indeed, an Examiner must identify "each and every facet or the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462 (Bd. Pat. App. & Interf. 1990). Each claim element in the cited reference must be identical to the element in the claim. *Glaverbel Société Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995).

Applicants respectfully request identification of the exact passages or terms in the reference that support the rejections. For example, what in Levchin is payment enabler, an enabler interface, a payment controller, and a handler interface, etc. Indeed, by not citing something in Levchin that describes these components, the Examiner cannot provide any cited art that describes the elements of the claims. Thus, the Examiner will fail to provide a *prima facie* case of anticipation. By understanding what the Examiner relates to these terms, Applicants will be better able to explain how very different the claims are from the cited art.

Due to the amendments, the Levchin reference can no longer support a *prima facie* case of obviousness. As such, Applicants request the Examiner to withdraw the rejection and allow the claims.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. Applicants do not acquiesce to any argument not specifically addressed herein. Rather, Applicants believe the amendments and arguments contained herein overcome all rejections presented.

Appl. No. 10/046,654
Amdt. dated November 5, 2008
Preliminary Amendment

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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